



Paper No. 7

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SEP 28 2001

**OFFICE OF PETITIONS**

In re Application of:	:	
Wheeler, et al.	:	DECISION REFUSING
Application No. 09/681,530	:	STATUS UNDER
Filed: 24 April, 2001	:	37 C.F.R. §1.47(a)
Attorney Docket No. 800528	:	

This is in response to the petition under 37 C.F.R. §1.47(a)<sup>1</sup> filed herein on 27 August, 2001, which supplemented the documents previously filed on 6 August, 2001.

The petition is **DISMISSED**.

**NOTES:**

- (1) Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)" and may include an oath or declaration executed by the inventor.

Failure to respond will result in abandonment of the application.

<sup>1</sup> The regulations at 37 C.F.R. 1.47 provide:

**§ 1.47 Filing when an inventor refuses to sign or cannot be reached.**

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in §1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in §1.17(h), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

(c) The Office will send notice of the filing of the application to all inventors who have not joined in the application at the address(es) provided in the petition under this section, and publish notice of the filing of the application in the *Official Gazette*. The Office may dispense with this notice provision in a continuation or divisional application, if notice regarding the filing of the prior application was given to the nonsigning inventor(s). [47 Fed. Reg. 41275, Sept. 17, 1982, effective Oct. 1, 1982; 48 Fed. Reg. 2709, Jan. 20, 1983, effective Feb. 27, 1983; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Nov. 7, 2000]

- (2) There is no indication in the file that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application, even though he has been designated to receive correspondence related to the application. An appropriate power of attorney must be submitted.

#### BACKGROUND

The record indicates:

- the application was filed on 24 April, 2001, without an executed oath or declaration;
- accordingly, a Notice to File Missing Parts of Application was mailed on 15 May, 2001, requiring an executed oath or declaration, and a surcharge for the late filing;
- a declaration executed by three of the four joint inventors, the surcharge for late filing, and a one month extension of time, were filed on 6 August, 2001;
- a Notice of Incomplete Reply was mailed on 16 August, 2001, indicating that the signature of inventor Paul Leury is missing from the declaration;
- a petition and petition fee were filed on 27 August, 2001.

#### ANALYSIS

Petitioner has failed to:

- obtain an extension of time for a second month to complete the response to the Notice to File Missing Parts (mailed on 15 May, 2001, with a 2-month shortened statutory deadline for response) after 15 August, 2001;
- establish that the inventor has been presented with the full application and has refused to sign the declaration (the proof of the pertinent events must be made by a statement of someone with first hand

knowledge of the events with support of the registered practitioner prosecuting this matter) or cannot be reached.

A copy of the application papers must be sent to the last known address of the non-signing inventor with a request that he/she sign the declaration for the patent application. Alternatively, an oath or declaration for the patent application in compliance with 37 C.F.R. §§1.63 and 1.64 must be presented. The declaration must set forth the inventor's residence, citizenship and post office address.

Petitioner has submitted three cover letters mailed to the non-signing inventor requesting that he sign a declaration and assignment forms attached thereto. Only the third of these letters, which was sent by certified mail and delivered to the non-signing inventor on 18 July, 2001, makes reference to the application papers, including the specification description, claims, and drawings, as being attached to the letter. The other two letters, as well as the declaration of facts of Gail Taylor Russell, make reference only to the declaration and assignment documents, but not the specification, claims, or drawings of the application. The letter requests that Mr. Leury respond by 24 July, 2001; the initial petition was then filed on 6 August, 2001.

A single communication to the non-signing inventor is insufficient to establish that the inventor has refused to sign the declaration, or to show that Petitioner has exercised due diligence in attempting to reach the non-signing inventor.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner of Patents and Trademarks  
Box DAC  
Washington, D.C. 20231

By FAX: (703) 308-6916  
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23  
2201 South Clark Place  
Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to Kathy Matecki at (703) 305-1645.

A handwritten signature in black ink, appearing to read "J. Gillon", with a stylized flourish at the end.

John J. Gillon, Jr.  
Attorney  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy